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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/822,883	04/13/2004	Kenneth Merdan	1001.1748101	4001

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CROMPTON, SEAGER & TUFTE, LLC  
1221 NICOLLET AVENUE  
SUITE 800  
MINNEAPOLIS, MN 55403-2420

EXAMINER
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ELVE, MARIA ALEXANDRA

ART UNIT	PAPER NUMBER
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1793

MAIL DATE	DELIVERY MODE
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01/24/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

Application No.

10/822,883

Applicant(s)

MERDAN ET AL.

Examiner

M. Alexandra Elve

Art Unit

1793

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 30 October 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1,5-21 and 23-29 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,5-21 and 23-29 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 13 April 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_.

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 5, 7-8, 10-17, 19, 21, 23-25 & 27-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Acciai et al. (USPN 5,855,802) in view of Pacetti et al. (USPN 6,695,920) and McCoy (USPAP 2003/0234243 A1).

Acciai et al. discloses a method and apparatus for forming a tubular article having a perforated annular wall, such as a surgical stent. Figure 3 shows a laser (40), a fiber optic (44), a beam splitter (42) and an optical guide (46). Note that the laser beam moves partially in a horizontal direction in the fiber optic and horizontally in the optical guide. The tubular member (32) is mounted in a chuck (34). The laser beams are focused by focusing mirrors (56 & 58) mounted at 45° (tuning mirror). The apparatus is supported by a precision table (66) and a table (68). The tubular member is rotated by a rotating means (36), powered by a rotary drive motor (38). The tubular member is moved in a horizontal (translational) direction by means of a linear drive motor (70). The laser beams (60 & 62) cut the tubular member, in this case a stent.

Acciai et al. does not teach all the elements mounted to one table, the coupling of the linear and rotary motors, the presence of guides, the workpiece below the motor(s), the direct cutting using the laser, or the use of a coolant.

Pacetti et al. discloses a mandrel apparatus for supporting a stent. The stent is connected to a rotational motor (24) and another motor (28), which provides linear directional motion (back and forth along a rail). In addition, gears members (22) (guides) and a rail (30) provide guide members.

It would have been obvious to one of ordinary skill in the art at the time of the invention to couple the motor(s) and provide guides (gear members for stent support and rails), as taught by Pacetti et al. in the Acciai et al. system because coupling the motors minimizes manufacturing real estate and guides support components and provides articles for motion.

McCoy discloses a multi-axis laser apparatus for the fine cutting of tubing (i.e. the making of stents). Tubes are affixed under a laser and positioned using a computer-generated signal in order to move the tube in a very intricate and precise pattern around a linear and rotary axis. A water system is incorporated in the apparatus to remove debris falling into the interior of the cut tube and to push discrete portions of the cut tube (or stents) into a parts catcher to separate the stent from the uncut portion of the tube. The tubing is feed by reciprocal relative movement through a cutting block by a collet relative to the clamp, which positions a finite length of the tubing beneath the beam. The pattern cut is controlled by movement of the tubing relative to the beam simultaneously along an X (length) and Y axis (rotary) controlled by a computerized encoder as part of

a CNC positioning equipment. A computer software controlled rotary and linear movement subassembly apparatus. The cutting of the tubing is conducted on an x-axis table, which has a combination of rotary (y-axis) and linear (x-axis) movements of the tubing relative to the cutting laser beam. (abstract, figures, 0017, 0019, 0025, 0028, 0033)

McCoy discloses:

The present invention provides an improved system for producing metal stents with a fine precision structure cut from a small diameter, thin-walled, cylindrical tube. The tubes are fixtured under a laser and positioned utilizing a computer generated signal to move the tube in a very intricate and precise pattern around a linear and rotary axis. The stent is cut from small diameter tubing held between a collet and clamp, one of which is periodically opened and the other reciprocally moved to position a small length of tubing, sequentially beneath the cutting head. A water system is incorporated in the apparatus to remove debris falling into the interior of the cut tube and to push discrete portions of the cut tube (or stents) into a parts catcher to separate the stent from the uncut portion of the tube. (abstract)

...a gas jet stream substantially surrounds the laser beam where the beam impinges on the working outer tube surface to aid in cutting said tubing. (claim 7)

It would have been obvious to one of ordinary skill in the art at the time of the invention to use a laser directly and use a coolant as taught by McCoy in the Acciai et al. apparatus and process because direct laser cutting while enhance efficiency and the coolant would yield greater precision because the debris would be removed during the laser machining.

Making elements integral was held to have been obvious. In re Wolfe 116 USPQ 443. Reversal of parts was held to have been obvious. In re Gazda 104 USPQ 400. Rearrangement of parts was held to have been obvious. In re Japikse 86 USPQ 70.

Claims 6 & 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Acciai et al., Pacetti et al. and McCoy, as stated above and further in view of Magnante (USPN 6,086,204)

Acciai et al., Pacetti et al. and McCoy teach a table/base, however, a granite base is not taught.

Magnante discloses:

...modified surfaces on contact lenses ... three dimensional contour cutting, laser ablation... (abstract)

...Correcting Surfaces on Lenses...

... Since the machine must be completely free of both internal and external vibrations, both lathe 30 and x-z slides 32 are secured to a pneumatically isolated table top 35 which rests on **granite base** 36. (col. 15, lines 44-45, 67 & col. 16, lines 25-27)

It would have been obvious to one of ordinary skill in the art at the time of the invention to use a granite base as taught by Magnante in the Acciai et al. Pacetti et al. and McCoy apparatus and process because it would ensure precision machining of the stent.

The type of materials chosen is a choice in design and substitution of known equivalent structures (table for granite) has been held obvious. In re Kuhle 188 USPQ (CCPA 1975), In re Ruff 118 USPQ 343 (CCPA 1958).

Claims 9 & 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Acciai et al., Pacetti et al. and McCoy, as stated above and further in view of Kranz (USPN 6,197,047).

Acciai et al., Pacetti et al. and McCoy teach a laser and the use of water, but a water laser is not specifically taught.

Kranz discloses:

A stent...

In a preferred embodiment of a stent according to the invention the partition lines are of a width substantially corresponding to that of a clean incision when the surface is severed by means of a cutting beam, e.g. a cutting jet of water preferably a laser beam. Narrow partition lines give the non-expanded stent particularly high stability. (col. 2, lines 29-34)

It would have been obvious to one of ordinary skill in the art at the time of the invention to use a water/laser cutting jet as taught by Kranz in the Acciai et al. Pacetti et al. and McCoy apparatus and process because it would ensure precision machining of the stent by removing cutting debris.

Claim 26 is rejected under 35 U.S.C. 103(a) as being unpatentable over Acciai et al., Pacetti et al. and McCoy, as stated above and further in view of Callol (USPN 6,464,723).

Acciai et al., Pacetti et al. and McCoy teach laser machining and machining of a stent/tubular material, however, a radiopaque material is not taught.

Callol discloses:

The stent may be constructed using any of a variety of techniques including fabricating the non-radiopaque series of linked rings and the radiopaque end rings separately and then subsequently joining them such as by laser welding. Alternatively, a tube may be constructed wherein a flat section of radio-transparent material is first joined to two flat strips of radiopaque material after which the joined material is formed into a cylinder. Fabrication of the stent may be accomplished in the conventional manner by then laser cutting or etching the cylinder to define an expandable configuration of struts.  
(col. 2, lines 55-65)

It would have been obvious to one of ordinary skill in the art at the time of the invention to use radiopaque material as taught by Callol in the Acciai et al. Pacetti et al. and McCoy apparatus and process because The type of materials chosen is a choice in design and substitution of known equivalent structures (radiopaque material for a stent) has been held obvious. In re Kuhle 188 USPQ (CCPA 1975), In re Ruff 118 USPQ 343 (CCPA 1958).

***Response to Arguments***

Applicant's arguments filed 10/30/07 have been fully considered but they are not persuasive.

Applicant argues that Acciai et al. teaches a laser but not a cutting laser. The examiner respectfully notes: In response to applicant's argument that the laser is not cutting, a recitation of the intended use of the claimed invention must result in a



structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. Furthermore, McCoy teaches a cutting laser.

Applicant argues that Acciai et al. and Pacetti et al. do not teach a pre and post-cut guide. The examiner respectfully disagrees because Pacetti et al. discloses a mandrel apparatus for supporting a stent. The stent is connected to a rotational motor (24) and another motor (28), which provides linear directional motion (back and forth along a rail). In addition, gears members (22) (guides) and a rail (30) provide guide members and McCoy discloses: The stent is cut from small diameter tubing held between a collet and clamp

Applicant argues that an up-side down motor is not taught. Reversal of parts was held to have been obvious. In re Gazda 104 USPQ 400. Rearrangement of parts was held to have been obvious. In re Japikse 86 USPQ 70.

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. See US PTO-892.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to M. Alexandra Elve whose telephone number is 571-272-1173. The examiner can normally be reached on 7:30-4:00 Monday to Friday.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jonathan Johnson can be reached on 571-272-1177. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

January 21, 2008.

/M. Alexandra Elve/  
M. Alexandra Elve  
Primary Examiner 1793